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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,729	08/26/1999	FRANK OSAN	514425-3732	2014
23416	7590	06/14/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/331,729

Applicant(s)

OSAN ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraph 1.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached, paragraph 2.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 48 and 53.

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 35, 36, 38, 39, 41-47, 49-52, 55, 56, and 58.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1555  
1700

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1. The "Amendments to the claims" filed in the amendment filed after the final rejection on Jun. 1, 2004 (Amdt060104), is not in compliance with 37 CFR 1.121. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified as set forth in 37 CFR 1.121. In particular, claim 49 is improperly labeled "presently amended". There are no indications that the claim has been amended. Therefore, the claim should be labeled as "Previously presented."

37 CFR 1.121(c) states that "the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn) . . . "

The paragraph proposed to be inserted at page 4, before the last line, of the specification, filed in Amdt060104, describing the conditions set forth in the German Standard DIN 53461-B (January 1987) for determining the values of the heat-distortion temperature (HDT), raises new considerations because the subject matter presented in the paragraph was not previously present in the specification. The proposed paragraph raises the issue of new matter. The originally filed specification does not define the German standard DIN 53461-B, or the experimental conditions under which the HDT is determined. Nor does the originally

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filed specification disclose the date of the particular version of the standard that was used.

Applicants assert that the "appropriate revision of the DIN 53461 would be the one that was currently in use at the time of the filing of the application (revised January 1987)."

Applicants further state that "[i]f applicants would have wanted the earlier version 1969 revision, the specification would have stated that."

However, as discussed above, there is no disclosure in the originally filed specification that would have lead a person having ordinary skill in the art to the inevitable conclusion that the version of the German DIN standard disclosed in the specification was that of January 1987. Nor is there any evidence on the present record that shows that the January 1987 version was the version currently used by applicants at the time the application was filed. Applicants' assertions are merely attorney arguments that are not supported by any evidence. For example, applicants have not provided an affidavit from an expert in the art that the DIN 5341-B of January 1987 was that used in the toner art during the filing date of the instant application.

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2. The terminal disclaimer filed on Jun. 1, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of copending US application 09/000,330 and US Patent No. 6,210,852, has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the rejections under the judicially created doctrine of obviousness-type double patenting of claims 35, 36, 44-47, 49, 55, and 59 over claims 1-5 of US Patent No. 6,210,852 B1 (Nakamura'852), and of claims 35, 36, 38, 39, 41, 46, 47, 49, 50, 51, 55, and 58, over claims 16-19 and 21-27 of copending US Application No. 09/000,330 in view of Diamond, Handbook of Imaging Materials, p. 170, and US 5,707,772 (Akimoto), set forth in the Final rejection mailed on Feb. 9, 2004 (CTFR020904), paragraphs 15 and 16, respectively, have been withdrawn.

3. The examiner's refusal to enter the amendment filed after the final rejection on Jun. 1, 2004 (Amdt060104), renders moot applicants' arguments regarding said amendment. Accordingly, the objections to the specification, the rejections of claims 35, 36, 38, 39, 41-47, 49-52, 55, 56, and 58 under 35 USC 112, second and first paragraphs, the objection to claim 47, and the rejection of claims 50-52 under 35 USC 102(a)

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over WO 97/05529, set forth in the final rejection mailed on Feb. 9, 2004, paragraphs 3, 7, 9, 10, and 13, respectively, stand.